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| 10/765,876 | 01/29/2004 | Tae-hee Lee | 1793.1098 | 2278 |
| 21171 7590 06/06/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | | |
| EXAMINER | | | | |
| KHAN, ASHER R | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/765,876

Applicant(s)

LEE, TAE-HEE

Examiner

ASHER KHAN

Art Unit

4134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-6 and 8 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1 - 6 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent Pub. 2004/0001704 A1 to Chan et al. ("Chan") in view of Korean Patent Publication No. P1997-0029482 to Bang.

As to **claim 1 and 6**, Chan discloses an apparatus for playing an optical disk, comprising: a first storage (Fig. 2, 115) storing a predetermined audio stream read out from an optical disk (0005)(0040); a second storage (Fig. 2, 120) storing a target still picture corresponding to the predetermined audio stream (0005)(0040); and a controller outputting the target still picture stored in the second storage when index information (6-1 to 6-N or 7-1 to 7-N) of the target still picture is received from a user(Fig. 6)(0032)(0037), so that the second and first storages store the index information of the target still picture and the predetermined audio stream, corresponding to the index information of the target still picture, respectively (0005)(0037)(0041-0042).

Chan does not expressly disclose comparing the received index information with a maximum number of indexes included in a predetermined track of the optical disk currently being played and outputting a storage control signal based on the comparison result.

Bang discloses comparing the received index information (Specific frame sequence data) with a maximum number of indexes included in a predetermined track (Comparing input frame sequence data with frame sequence data of a video) of the optical disk currently being played and outputting a storage control signal (video signal) based on the comparison result (Abstract).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to combine Chan and Bang. Motivation would have been to provide a search operation in a reproducing device to output desired image to view on a display device (Abstract).

As to **claim 2**, Bang further discloses wherein the controller comprises a comparator comparing the index information of the target still picture with the maximum number of indexes included in the predetermined track (Comparing input frame sequence with frame sequence data of a video) and outputting the storage control signal (video) when the index information of the target still picture has a value not larger than the maximum number of indexes included in the predetermined track (Abstract). In addition, the same motivation is used as the rejection for claim 1.

As to **claim 3**, Chan discloses a method of playing an optical disk, comprising: outputting a still image designated by a predetermined index during a predetermined

audio stream reproduced from an optical disk (0037); and jumping from a current index to a predetermined index corresponding to the index information of the target still picture if the index information of the target still picture has a value not larger than the maximum number of indexes included in the predetermined track (0020)(0037).

Chan does not expressly disclose comparing index information of a target still picture with a maximum number of indexes included in a predetermined track of the optical disk currently playing when the index information of the target still picture is received from a user.

Bang discloses comparing index information of a target still picture with a maximum number of indexes included in a predetermined track of the optical disk currently playing when the index information of the target still picture is received from a user (Abstract). In addition, the same motivation is used as the rejection for claim 1.

As to **claim 4**, Chan further discloses wherein the jumping from a current index to a predetermined index corresponding to the index information of the target still picture comprises outputting the target still picture indicated by the predetermined index, and simultaneously reproducing an audio stream corresponding to playback time designated by the predetermined index (0003)(0020)(0037).

As to **claim 5**, Chan discloses a method of playing an optical disk in an optical disk player, comprising: inputting index information of a still picture other than one currently being played (Figs. 4 and 6)(0032)(0036)(0037); storing the read still picture (0021)(0040-0042); checking playback time designated by the index information and

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reading audio stream data corresponding to the playback time from the optical disk (0020)(0036-0037); storing the audio stream (0021)(0040-0042); and reproducing the still picture and the audio stream (0020).

Chan does not expressly disclose comparing the input index information with a maximum number of still pictures in a first track of the optical disk and reading a still picture from the optical disk, corresponding to the input index information if the input index is less than the maximum number of still pictures in the first track.

Bang discloses comparing the input index information (Specific frame sequence data) with a maximum number of still pictures in a first track of the optical disk (Video in a tape) and reading a still picture from the optical disk, corresponding to the input index information if the input index is less than the maximum number of still pictures in the first track (Abstract). In addition, the same motivation is used as the rejection for claim 1.

As to **claim 8**, Chan discloses a method of playing an optical disk in an optical disk player, the method comprising:
inputting index information of a still picture other than one currently being played (Figs. 4 and 6)(0032)(0036)(0037); checking playback time designated by the index information and reading audio stream data corresponding to the playback time from the optical disk(0020)(0036-0037);
reproducing the still picture and the corresponding audio stream in place of the one currently being played (Figs. 4 and 6; 0037; While playing a slide show a user may

choose to play a different still image file and corresponding audio stream using remote control and menu of fig 6 using remote control of fig 4).

Chan does not expressly disclose comparing the input index information with a maximum number of still pictures in a first track of the optical disk and reading a still picture from the optical disk, corresponding to the input index information if the input index is less than the maximum number of still pictures in the first track.

Bang discloses comparing the input index information (Specific frame sequence data) with a maximum number of still pictures in a first track of the optical disk (Video in a tape) and reading a still picture from the optical disk, corresponding to the input index information if the input index is less than the maximum number of still pictures (when an image is searched all the images will be searched until a desired image is found and when image is found then index must be less than a maximum number of still pictures) in the first track (Abstract; Page 3 and claim 3). In addition, the same motivation is used as the rejection for claim 1.

Therefore it would have been obvious to combine Chan with Bang to make the modifications described in claims 1 - 6 and 8.

Response to Arguments

3. Applicant's arguments filed 4/22/2008 with regards to claim 5 have been fully considered but they are not persuasive.

On Page 7 Applicant also argues that "video in a tape" can not be relied upon to disclose "first track of the optical disk".

Examiner respectfully disagrees because Bang teaches videotape for storing still picture(see abstract and claim 1) and Chan teaches a DVD(optical disk) for storing images(see paragraphs 0002-0003). It is inherent that the videotape or DVD(optical disk) having tracks. In addition. the U.S. Patent 5,012,352 to Yoshimura et al. "Yoshimura" teaches a video tape or cassette has tracks as on which video and audio are stored, as shown in column 5 lines 23 -32 and figures 8, 13 and 14.

Applicant also argues on page 7 that Bang abstract is silent to " a maximum number of still pictures".

Examiner respectfully disagrees because still image search apparatus of Bang searches for desired image as shown in claim one on page 2 of bang translation. It is noted that when an image is searched all the images will be searched until a desired image is found. Therefore it will also include a maximum number of still pictures.

Applicant also argues on page 7 that "frame sequence data" is not the same as "index information of a disk".

Examiner respectfully disagrees because claim 1 on page 2 of Bang translation clearly states that frame sequence data is provided by the instruction issue part (100) to search for a desired video frame. Therefore frame sequence is an index required in searching the desired image. Even in applicant specification an index is defined as means for searching a target or desired still picture.

Therefore the reference teachings are equivalent to the Applicants specification.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHER KHAN whose telephone number is (571)270-5203. The examiner can normally be reached on Monday-Friday 9:30 am - 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lun Yi can be reached on (571)272-7671. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. K./

Examiner, Art Unit 4134

/LUN-YI LAO/

Supervisory Patent Examiner, Art Unit 4134